



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/758,853 | 01/16/2004 | Mark E. Peters | RSW920030243US1 (132) | 6950 |
| 46320 7590 07/19/2010 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 2022 BOCA RATON, FL 33487 | | | | |
| EXAMINER | | | | |
| FIELDS, BENJAMIN S | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3684 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 07/19/2010 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK E. PETERS

Appeal 2009-006756
Application 10/758,853
Technology Center 3600

Before: MURRIEL E. CRAWFORD, ANTON W. FETTING and JOSEPH
A. FISCHETTI, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-7, 9-13, and 15-18. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to processing payment requests with mobile server wallets in a payment transaction management network (Spec. [0002]). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A mobile server wallet provider (MSWP) portal comprising:
 - a configuration for communicative coupling both to a plurality of MSWPs and also a content proxy;
 - a composite profile generator configured to combine a plurality of MSWP profiles into a single, composite profile for routing payment messages in said proxy to the MSWP portal; and,
 - selection logic configured to process a user selection of one of said MSWPs to process a payment transaction received through said proxy.

The references of record relied upon by the Examiner as evidence of obviousness are:

| | | |
|--------|--------------------|---------------|
| Suzuki | US 2002/0032616 A1 | Mar. 14, 2002 |
| Schuba | US 2002/0052842 A1 | May 2, 2002 |

Claims 1-7, 9-13, and 15-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Suzuki in view of Schuba.

ISSUE

Did the Examiner err in asserting that a combination of Suzuki and Schuba renders obvious “a composite profile generator configured to

combine a plurality of MSWP profiles into a single, composite profile for routing payment messages in said proxy to the MSWP portal,” as recited in independent claim 1?

FINDINGS OF FACT

Suzuki discloses that a preferable mode is one wherein the information, having been transmitted from the wallet server to the user terminal, is confirming information used for the user to confirm details of the transaction based on the payment information transmitted from the shop server to the wallet server and the predetermined item of the confirming information contains at least amounts to be paid out of the payment information ([0021]).

Suzuki discloses that a further preferable mode is one wherein the payment system is provided with a plurality of the wallet servers, and the information out of which the predetermined item is to be selected by the contents converting section is information used by the user to select the wallet server for the payment out of the plurality of the wallet servers ([0030]).

ANALYSIS

The Examiner asserts that paragraphs [0021] and [0030] of Suzuki disclose the composite profile generator of independent claim 1 (Exam’r’s Ans. 16). While we agree that paragraph [0030] of Suzuki discloses a plurality of wallet servers, the aforementioned portion of Suzuki does not disclose that the profiles of the plurality of wallet servers are combined into a single profile. Moreover, the Examiner has not provided any evidentiary

basis for showing that combining the plurality of wallet servers into a single profile would have been obvious. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988) (in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness). The Examiner's assertion that creating a composite profile for a user/subscriber is well-known does not have any evidentiary basis, nor does it address combining multiple MSWP profiles into a single profile, as claimed (Exam'r's Ans. 10). Accordingly, a proper case of obviousness has not been established. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (during examination, the examiner bears the initial burden of establishing a prima facie case of obviousness).

The Examiner also cites Schuba as remedying certain deficiencies of Suzuki (Exam'r's Ans. 9-10, 14-18). However, Schuba is only cited for disclosing a portal, and not for the recited composite profile generator.

REVERSED

hh

CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 2022
BOCA RATON, FL 33487